

Notice of Allowability

Application No.

10/008,757

Examiner

Jerry A. Lorengo

Applicant(s)

RODRIGUEZ ET AL.

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendments and arguments filed 11/05/2003.
2. ☒ The allowed claim(s) is/are 1-23.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☒ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☒ to Paper No. 3.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892) | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6 <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____. |
| 3 <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No. _____ | 7 <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other _____ |

DETAILED ACTION

(1)

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8 and 18-23, drawn to an adhesive applicator for applying a strip of double-sided pressure sensitive adhesive, classified in class 156, subclass 540.
- II. Claims 9-17, drawn to an apparatus for cutting a moving web of paper being wound on a spool including an adhesive applicator for applying a strip of double-sided adhesive to a cutting tape to be applied to the moving paper web, classified in class 242, subclass 526.2.
- III. Claims 24-30, drawn to a method for applying a strip of double-sided pressure sensitive adhesive to a cutting tape surface, classified in class 156, subclass 230.

The inventions are distinct, each from the other because of the following reasons:

Inventions III and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as the application of strips of double-sided pressure sensitive adhesive to envelope flaps in an envelope sealing apparatus.

Inventions III and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by hand using a manually held and operated adhesive applicator for applying a strip of double-sided pressure sensitive adhesive to the cutting tape surface.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant

Art Unit: 1734

case, the combination as claimed does not require the particulars of the subcombination as claimed because the adhesive applicator for applying a strip of double-sided pressure sensitive adhesive need not be incorporated in an apparatus for cutting a moving web of paper being wound on a spool. The subcombination has separate utility in other combinations such as an apparatus used for applying a strip of double-sided pressure sensitive adhesive to an envelope flap in an envelope sealing apparatus.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Arthur Yeager on August 11, 2003 a provisional election was made with traverse to prosecute the invention of Group II, claims 9-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-8 and 18-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

(2)

Allowable Subject Matter

Claims 9-17 have been found to be allowable over the prior art of record.

(3)

The following is an examiner's statement of reasons for allowance:

Apparatus for cutting an moving web of paper being wound on a spool with a cutting tape which include an adhesive applying means for applying a strip of PSA adhesive onto the cutting tape, such as taught by U.S. Patent Nos. 5,954,290 to Rodriguez et al.; 5,456,792 to Rodriguez et al.; 5,046,675 to Rodriguez et al.; and 4,783,018 to Rodriguez, are known in the art. Rodriguez '675, for example, disclose one such apparatus wherein the PSA is applied to the cutting tape from a double-sided adhesive tape disposed upon a strippable release film. Although adhesive

tape transfer devices are known in the art, such as those disclosed by U.S. Patent Nos. 5,658,420 to Rossini; 5,504,908 to Fukushima et al.; 4,758,303 to Shastko; and 4,636,276 to Nozaka, which utilize a rounded peeling edge to separate the adhesive from the release liner, none of the prior art of record specifically teach or suggest an apparatus for cutting a moving web of paper being wound on a spool with a cutting tape, wherein an adhesive applying means for applying a strip of double-sided pressure sensitive adhesive to the cutting tape is utilized which comprises:

- (1) A housing having an upper portion and a lower portion;
- (2) A rotatable supply roll having layers of spaced strips with exposed face sides and unexposed back sides with each side having a PSA thereon and backsides being adhered to an elongated continuous release liner, said supply roll being positioned generally medially of the upper portion;
- (3) A stationary nose member mounted to the housing and having a rounded tip exposed outwardly of the housing and being disposed at a proximal end of the upper portion of the housing above the supply roll; and
- (4) A press member positioned diametrically opposite and above the rounded tip and being vertically moveable downwardly to force an exposed face side of an adhesive strip on the rounded tip into contact with the lower surface of a generally horizontally incoming cutting tape to cause an exposed face side to adhere to a lower surface of the cutting tape and separate from the release liner when the release liner rotates around the tip.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

(4)

Conclusion

This application is in condition for allowance except for the following formal matters:

This application is in condition for allowance except for the presence of claims 1-8 and 18-30 drawn to inventions non-elected with traverse as set forth in section (1), above.

Application/Control Number: 10/008,757

Page 5

Art Unit: 1734

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

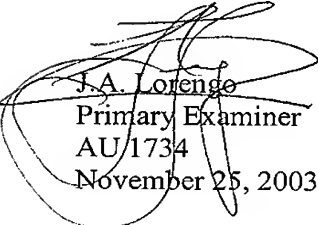
A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

(5)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry A. Lorengo whose telephone number is (703) 306-9172. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7115 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



J.A. Lorengo
Primary Examiner
AU/1734
November 25, 2003